

MAIL STOP APPEAL BRIEF - PATENTS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants/
Petitioners: N.E. Morrow et al. Attorney Docket No.: KMOR116839

Application No.: 09/761,340 Group Art Unit: 3728

Filed: January 16, 2001 Examiner: J.T. Kavanaugh

Title: STEP-IN SNOWBOARD BINDING AND BOOT THEREFOR

REPLY BRIEF

Seattle, Washington 98101 TECHNOLOGY CENTER

July 14, 2003

TO THE COMMISSIONER FOR PATENTS:

This reply brief is being submitted in response to the Examiner's Answer, mailed on May 14, 2003.

The Rejection of Claims 68 and 99-102 Under 35 U.S.C. § 112, Second Paragraph

Claims 68 and 99-102 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that applicants regard as the invention.

The Examiner states that "the term 'unrestrained' used in Claims 99, 100, and 101 is unclear, inaccurate and indefinite. The cable portion as claimed is under tension and therefore is not unrestrained at any portion of the cable." Petitioners respectfully disagree.

Petitioners find no justification why the Examiner insists that the cable or cable portions have to be under tension. The claims are silent with respect to tension. WEBSTER'S 9TH NEW COLLEGIATE DICTIONARY defines unrestrained as 1: not restrained; 2: free of constraint. As claimed in Claim 99, for example, "the second cable portion extending from the second guide unrestrained to the third guide" was understood by the Examiner to mean with no other

intervening guides. Examiner's Answer, p. 8. The claims are thus clear to a reasonable degree. A claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought. *In re Swinehart and Sfiligoj*, 169 USPQ 226, 229 (C.C.P.A. 1971).

With regard to Claim 68, the Examiner states that "it is not clear what 'first and second locations' of the front portion 'are substantially adjacent each other.'" The Examiner asks, "what locations is applicant referring to?" Petitioners submit that the term "locations" is reasonably clear to one of ordinary skill when taken in the context of Claims 65 and 68, as was intended. Petitioners have, in essence, recited in Claim 68 that the medial and lateral cable members are attached to a front portion of the boot at first and second locations that are substantially adjacent each other, i.e., the locations where the medial and lateral cables are attached are substantially adjacent each other. This is clear from Claim 68 when read in light of Claim 65. Therefore, Claim 68 is not indefinite.

The Rejection of Claims 57, 58, 60, 61, 65, 68, 69, 72, 97, 98, and 102 Under 35 U.S.C. § 102(b)

Claims 57, 58, 60, 61, 65, 68, 69, 72, 97, 98, and 102 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,060,403 to Battistella.

Independent Claims 57, 65, 97, and 102 are directed to a boot that has a "forward-lean system", generally comprising medial and lateral cables on either side of the boot, respectively, wherein the cables are attached to a single general area on the forward part of the boot. A forward-lean system is a term of art that is recognized by persons skilled in the art to denote apparatus intended to induce an adjustable forward leaning configuration to a boot.

The generalizations regarding functional claim language in the paragraph bridging pages 4 and 5, and at other locations, found in the Examiner's Answer, are vague as to which claims or

element, the statements are directed toward. Petitioners have assumed the statements are addressed to "forward-lean system". Forward-lean system is not merely functional language, but structure imposed upon the claimed apparatus, which differentiates the claims from Battistella.

Battistella is directed to an adjustable closure device particularly for ski boots of the rear-entry type. See Col. 1, lines 6-7. The aim of Battistella is to provide a device for closing the quarters of a ski boot of the rear-entry type and for allowing the skier to walk easily. See Col. 2, lines 29-33. The Examiner insists that not only Battistella, but Spademan (U.S. Patent No. 4,360,979) and Ottieri (U.S. Patent No. 4,969,278), have forward-lean systems because "all ski boots have the uppers leaning forward" and because the system of Battistella, Spademan, and Ottieri, "naturally controls the forward lean of the boot." Examiner's Answer, pp. 9, 10, and 11, respectively. The former statement is overly broad, and indicates a basic lack of comprehension of the law on claim construction. The latter statement is so vague as to be meaningless and without basis in the references. The Examiner is imposing an unreasonably broad meaning to forward-lean system. The Federal Circuit recognizes a "strong presumption" that claim terms carry their ordinary meaning as viewed by one of ordinary skill in the art. See, *Apex Inc. v. Raritan Computers, Inc.*, 66 USPQ2d 1444, 1449 (Fed. Cir. 2003). Moreover, claims are interpreted in light of the specification and with the knowledge of one of ordinary skill in the art. *Vitronics Corp. v. Conceptronic, Inc.*, 39 USPQ2d 1573, 1576-77 (Fed. Cir. 1996). The specification assigns "forward-lean system" with structure. See, for example, page 5, lines 17 - 22. The Examiner's construction of "forward-lean system" is (1) unreasonably broad, (2) not what a person who is skilled in the art would ascribe to it, i.e., does not imply simply function, and (3) contrary to the use made throughout the specification. The Examiner simply appears to note that the words "forward" and "lean" appear in the respective patents without so much as describing how any one of the applied references implements adjustment of forward lean. The

mechanical key-word approach to anticipation taken by the Examiner is contrary to the objectives of patent law to reward inventors because such method ignores the limitations of the English language to keep pace with new inventions. None of the applied references has a forward-lean system. For a reference to be anticipatory, "every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim," *Brown v. 3M*, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001). Spademan is directed to an adjustable leg cuff for a ski boot (see the abstract of Spademan), and Ottieri is directed to a ski boot that has an inner shell with a selectively variable volume (see Col. 1, lines 65 - 66). The general characterization of all prior art and vague statement regarding the references are not evidence of anticipation in any one of Battistella, Spademan, and Ottieri.

Additionally, Battistella does not describe cables on the respective rear upper opposite sides of the boot, wherein the cables attach to a single general area located at the front, lower portion of the boot. In this regard, reference is made to the Appeal Brief, page 8, the first full paragraph.

Battistella does not have a forward-lean system, nor does Battistella have medial and lateral cable portions wherein the cable members are attached to the forward portion of the boot at only one general position. For at least these reasons, Battistella does not anticipate Claims 57, 58, 60, 61, 65, 68, 69, 72, 97, 98, and 102.

The Rejection of Claims 57-59, 65, 68, and 69 Under 35 U.S.C. § 102(b)

Claims 57-59, 65, 68, and 69 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,360,979 to Spademan.

Independent Claims 57 and 65 are directed to a boot having a forward-lean system with medial and lateral cables. Spademan has neither a forward-lean system nor medial and lateral cables. Contrary to what the Examiner is appearing to imply, Spademan does not have structure

resembling a forward-lean system. In Col. 5, lines 42-49, Spademan is describing the action caused when the *user* leans forward. In response to the user leaning forward, the cuff tightens about the leg. See also Col. 6, lines 46-64.

Furthermore, Spademan does not have medial and lateral cable members. In the claimed embodiment of the invention, cable members are located on the respective, opposite, sides of the boot, thus the designation of *medial* and *lateral* cable members. The Examiner refers to the cables on one side of the boot in Spademan, respectively, a lateral and a medial cable, despite both cables being configured on the same side of the boot, other than one being higher on the boot than the other. By the Examiner's test, how can one know which is the lateral and which is the medial cable? Claims 57 and 65 recite "medial and lateral side cable members on the boot," not first and second cable members, which is how the Examiner, in essence, seems to be construing the claims.

The Rejection of Claims 99-101 Under 35 U.S.C. § 102(b)

Claims 99-101 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,969,278 to Ottieri.

Claims 99-101 are related to a boot having a forward-lean system with at least three guides. The first and second guides are located on the boot on the same side. The first guide is on the upper rear portion of the boot and the second guide is on a lower front portion of the boot. A cable is provided unrestrained from the first to the second guide.

Ottieri does not, at least, have a second guide located on the same side as the first guide on a lower, front portion of the boot. The Examiner states that the second guide is lower than the first guide and that the cable is clearly sloping slightly downward toward the front of the boot. Examiner's Answer, page 11. Irrespective of this, the second guide remains on an upper portion of the boot, and is therefore not on a lower front portion of the boot, as claimed.

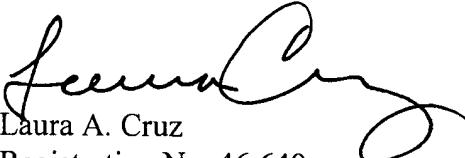
The Examiner states that FIGURE 1 shows the first and second guide on the same side simply because they appear in one view. Examiner's Answer, page 11. However, the boot configuration is more realistically shown in Figure 2, in Ottieri. The second guide is not on either the lateral or medial side, but straddles a middle position between the lateral and medial sides.

CONCLUSION

In view of the above remarks, Petitioners respectfully submit that each of Claims 57-61, 65, 68, 69, 72, and 97-102 is patentable over the references of record. A decision reversing the Examiner's rejections and finding all pending claims to be in condition for allowance is respectfully requested.

Respectfully submitted,

CHRISTENSEN O'CONNOR
JOHNSON KINDNESS^{PLLC}



Laura A. Cruz
Registration No. 46,649
Direct Dial No. 206.695.1725

I hereby certify that this correspondence is being deposited with the U.S. Postal Service in a sealed envelope as first class mail with postage thereon fully prepaid and addressed to Mail Stop APPEAL BRIEF - PATENTS, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the below date.

Date: July 14, 2003

LAC:ejh/tm/jam/tm/ws